

REMARKS

This is a full and timely response to the outstanding final Office Action mailed March 2, 2005. Upon entry of the amendments in this response, claims 1 - 30 remain pending. In particular, Applicants have amended claims 1, 6, 8, 10, 15 and 22, and has added claims 27 - 30. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Response to Arguments

The Office Action indicates that Applicants' arguments filed on 9/27/2004 were considered but are not persuasive. Specifically, the Office Action states that:

- a) Applicant's argument stated as "Nielsen involves alteration of an email message, not an email attachment."

In response to the Applicant's argument regarding claim 1, *Examiner respectfully disagrees because the document attached to the email is very simple to modify, the importance is the ability to send an email to the same recipients. Mere adding one or two words to differ from the prior art will not effect the prior art.*

(Final Office Action, page 15 to page 16). (Emphasis added).

Applicants respectfully assert that the above-mentioned portion of the Office Action appears to be flawed in several respects. First, the rejection of claim 1 was asserted under 35 U.S.C. 102, which requires that all elements of a claim be taught in a single reference - in this case, *Nielson*. Applicants respectfully pointed out in the last response that claim 1, which was amended to recite "an email attachment," was no longer properly rejected under *Nielson*, because *Nielson* does not teach the use of an email attachment as recited in amended claim 1. The fact that the Office Action considers that a "document attached to an email is very simple to modify" does not render a rejection under 35 U.S.C. 102 proper, when that element is not taught by the asserted reference.

Second, the Office Action appears to be indicating that the addition of one or two words cannot distinguish a claim from the prior art. Applicants respectfully inquire how this can be the case, when claim language is routinely amended to distinguish over prior art? In fact, this is one of the ways indicated in the MPEP as enabling Applicants to negotiate a proper scope of claim protection. Certainly, if a pending rejection is lodged under 35 U.S.C. 102, and a claim is amended to recite an element that is not taught in the cited reference, such an amended claim would avoid the art and render the rejection moot.

Third, the Office Action appears to be stating that the importance of Applicants' invention is the ability to send an email to the same recipients. Not only is this an incorrect assumption, it is improper to examine claims without regard to the language of the claims themselves. Specifically, some embodiments of Applicants' invention are considered meritorious because they provide a user with the ability to modify documents that are to be reviewed by others, and have those documents sent automatically to the other reviewers when modifications are made to the documents by the user, for example. Therefore, Applicants respectfully requests that examination be based on the claim language and not on any perceived importance of the invention.

Rejections Under 35 U.S.C. §102

The Office Action indicates that claims 1 – 5, 10 – 15, 19 – 22 and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Nielsen*. Applicants respectfully traverse the rejection.

With respect to *Nielsen*, that reference generally involves a method and apparatus for altering sent electronic mail messages. As disclosed in *Nielsen*:

One aspect of the invention is a computer controlled *method for allowing an e-mail sender to alter a previously-sent electronic mail message* addressed to a recipient whose computer is beyond the scope of control of the

sender's computer. *The sender first selects which previously-sent message to alter. The invention then constructs an action message and sends the action message to the recipient's computer where it is received.* (Nielsen, col. 3. Lines 10 – 17). (Emphasis Added).

As disclosed in the exemplary teaching of *Nielsen* above, *Nielsen* involves alteration of an email message, not of an email attachment. This aspect of Applicants' invention was described in Applicants' last response.

Irrespective of the apparent inapplicability of the present rejection under 35 U.S.C. 102, Applicants have amended several of the claims. In particular, claim 1 has been amended to recite:

1. A method for sending documents, comprising:
determining whether a user sent a copy of a document, created by an application other than an email application, as an email attachment to a first set of at least one recipient via email; and
if the user sent the copy of the document to the at least one recipient of the first set as an email attachment using an email application, correlating information with the document so that a copy of a revised version of the document can be sent automatically as another email attachment to the at least one recipient of the first set without the user accessing the email application.

(Emphasis Added).

Applicants respectfully assert that *Nielsen* does not teach or otherwise disclose at least the features/limitations emphasized above in claim 1. Specifically, *Nielsen* does not involve use of a document created by an application other than an email application, much less use of an email attachment as described above. Additionally, *Nielsen* requires a user to select an email for modification, therefore, clearly involving accessing of the email application. This is in direct contrast to the features recited in claim 1. Therefore, Applicants respectfully assert that the rejection of claim 1 has been rendered moot and that this claim is in condition for allowance.

Since claims 2 - 5 and 10 - 14 are dependent claims that incorporate all the features/limitations of claim 1, Applicants respectfully assert that these claims also are in

condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

By way of example, claim 10 recites:

10. The method of claim 2, further comprising:
automatically enabling the at least one recipient of the first set to obtain the copy of the revised version of the document if the at least one recipient of the first set accesses the copy of the document *such that, when the at least one recipient of the first set attempts to open the email attachment previously sent and corresponding to the copy of the document, the at least one recipient is automatically provided with access to the copy of the revised version of the document.*

(Emphasis Added).

Applicants respectfully assert that *Nielsen* does not teach or reasonably disclose at least the additional features/limitations emphasized above in claim 10. In particular, *Nielsen* does not describe an attempt to open an email attachment, much less a recipient being automatically provided with access to the copy of the revised version of the document. Therefore, Applicants respectfully assert that at least this claim clearly is in condition for allowance.

With respect to claim 15, that claim has been amended to recite:

15. A communications system, comprising:
a document-sending system configured to:
determine whether a user sent a copy of *a document created by an application other than an email application* and attached to an email message to a first set of at least one recipient via email; and
correlate information with the document so that a copy of a revised version of the document can be sent automatically as an attachment to another email message without the user accessing the email application, if the user sent the copy of the document to the at least one recipient of the first set as an email attachment using an email application.

(Emphasis Added).

Applicants respectfully assert that *Nielsen* does not teach or otherwise disclose at least the features/limitations emphasized above in claim 15. Specifically, *Nielsen* does not involve use of a document created by an application other than an email application, much less use of

an email attachment as described above. Additionally, *Nielson* requires a user to select an email for modification, therefore, clearly involving accessing of the email application. This is in direct contrast to the features recited in claim 15. Therefore, Applicants respectfully assert that the rejection of claim 15 has been rendered moot and that this claim is in condition for allowance.

Since claims 16 - 21 are dependent claims that incorporate all the features/limitations of claim 15, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

With respect to claim 22, that claim has been amended to recite:

22. A computer-readable medium storing a computer program for sending documents, the computer-readable medium comprising:
logic configured to determine whether a user sent a copy of *a document created by an application other than an email application* and attached to an email message to a first set of at least one recipient via email; and
logic configured to correlate information with the document so that a copy of a revised version of the document can be sent automatically attached to another email message without the user accessing the email application, the logic correlates the information if the user sent the copy of the document to the at least one recipient of the first set as an email attachment using an email application.

(Emphasis Added).

Applicants respectfully assert that *Nielson* does not teach or otherwise disclose at least the features/limitations emphasized above in claim 22. Specifically, *Nielson* does not involve use of a document created by an application other than an email application, much less use of an email attachment as described above. Additionally, *Nielson* requires a user to select an email for modification, therefore, clearly involving accessing of the email application. This is in direct contrast to the features recited in claim 22. Therefore, Applicants respectfully assert that the rejection of claim 22 has been rendered moot and that this claim is in condition for allowance.

Since claims 23 - 26 are dependent claims that incorporate all the features/limitations of claim 22, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

Rejections Under 35 U.S.C. §103

The Office Action indicates that claims 6 – 9, 16 – 18 and 23 - 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Nielsen* in view of *Naylor*. Applicants respectfully traverse the rejections. Specifically, Applicants respectfully assert that the combination of *Nielsen* and *Naylor* is legally deficient for the purpose of rendering obvious the features/limitations recited in the claims currently pending rejection under 35 U.S.C. 103. In particular, Applicants respectfully assert that *Naylor* does not teach or reasonably suggest at least the features/limitations emphasized above as lacking in *Nielsen* as discussed in Applicants' response to the rejections under 35 U.S.C.102.

Since neither, nor a combination of these references, teaches or reasonably suggests at least these features/limitations recited in the respective independent claims, Applicants respectfully assert that the dependent claims stand improperly rejected and are, thus, in condition for allowance.

Newly Added Claims

Upon entry of the amendments in this response, Applicants have added claims 27 – 30. Applicants respectfully assert that these claims are in condition for allowance. In particular, with respect to claim 27, Applicants respectfully assert that this claim is in condition for allowance for at least the reason that claims 27 is a dependent claim that

incorporates all the features/limitations of claim 1, the allowability of which is described above.

With respect to claim 28, that claim recites:

28. A method for sending information via email, comprising:
creating a file using an application other than an email application;
attaching the file to an email message as a first email attachment;
designating a first recipient to receive the email message with the first email attachment; and
correlating information with the file so that a revised version of the file is automatically sent to the first recipient as a second email attachment via a subsequent email in response to the file being revised using the application.

(Emphasis Added).

Applicants respectfully assert that the cited art, either individually or in combination, does not teach or reasonably suggest at least the features/limitations emphasized above in claim 28. Specifically, neither *Nielson* nor *Naylor* involves creating a file using an application other than an email application, much less use of an email attachment as described above. Therefore, Applicants respectfully assert that claim 28 is in condition for allowance.

Since claims 29 - 30 are dependent claims that incorporate all the features/limitations of claim 28, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

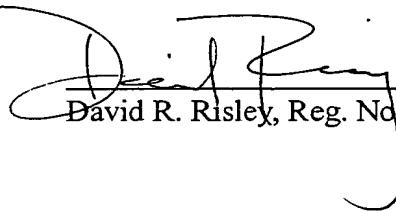
Cited Art Made of Record

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David R. Risley, Reg. No. 39,345

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 4/19/05.

Stephanie Riley
Signature